



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shingo ITOH

Group Art Unit: 2853

Application No.: 10/797,131

Examiner: L. MARTIN

Filed: March 11, 2004

Docket No.: 119052

For: DOUBLE-SIDED RECORD APPARATUS AND DOUBLE-SIDED RECORD
METHOD

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the January 15, 2008 Election of Species Requirement, the period for reply being extended by the attached Petition for Extension of Time, Applicant provisionally elects "Species" 2, "sub-species" 1a, "sub-species" 2d, "sub-species" 3a and "sub-species" 4b.

Species 2 corresponds to claims 24, 30 and 36. Sub-species 1a corresponds to claim 5. Sub-species 2d corresponds to claim 11. Sub-species 3a corresponds to claims 15 and 34. Sub-species 4b corresponds to claim 19. This Election is made with traverse.

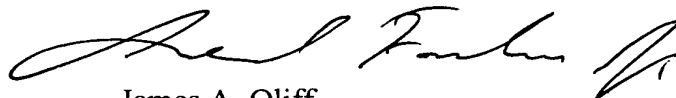
The January 15, 2008 Election of Species Requirement indicates that the alleged Species 1 corresponds to claims 1-23, 27-29 and 32-35, and that Species 1 is generic to all species and will be examined along with the elected species. As discussed above, Applicant elects Species 2, and Sub-species 1a, 2d, 3a and 4b. Accordingly, Applicant respectfully requests that at least claims 1-5, 7, 11-15, 17, 19, 21-24, 27-30, 32-34 and 36 be examined.

Notwithstanding the above election with traverse, Applicant notes that the January 15, 2008 Election of Species Requirement is improper. Claims that are generic (the claims correlated with "Species" 1) cannot be a species. Furthermore, for two or more features to be considered "species," they must be mutually exclusive (that is, they can not both exist at the same time). For example, a screw and a rivet are two different species of the genus "connector." Something cannot be both a screw and a rivet. The Office Action does not apply this proper standard in its "election of species" requirement.

It is also respectfully submitted that the subject matter of all Species and/or Sub-species is sufficiently related that a thorough search for the subject matter of any one Species and/or Sub-species would encompass a search for the subject matter of the remaining Species and/or Sub-species. For example, as evidenced by the examination of all pending claims in the November 6, 2006 and June 25, 2007 Office Actions, a thorough search for the subject matter of any one Species and/or Sub-species encompassed a search for the subject matter of the remaining Species and Sub-species. Thus, it is respectfully submitted that the search and examination of the entire application could be (and already has been) made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office.

In view of the foregoing, it is respectfully submitted that claims 1-37 can be examined without undue burden on the Examiner. Thus, withdrawal of the Election of Species Requirement is respectfully requested.

Respectfully submitted,



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JAO:LXF/mld

Attachment:
Petition for Extension of Time

Date: March 11, 2008

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